

then asserts, without specificity as to where the teaching can be found, that the same feature can be found in the Teshima or Roewer reference. In effect, the Examiner is putting words (namely, Applicant's claim limitation) into the mouth of the inventor of the prior art reference. Close inspection of the cited references reveals that Applicant's claim language cannot be found in the references.

For example, in support of the rejection of claim 1, the Examiner states that:

Teshima discloses . . . an exam description list manager programmed to manage a list of exam descriptions . . .

This language, however, is taken verbatim out of Applicant's claim, not out of the reference's disclosure. Close inspection of the Teshima patent reveals the following: (1) the term "exam description" appears nowhere in Teshima; (2) the term "list manager" appears nowhere in Teshima; and (3) the term "list of exam descriptions" appears nowhere in Teshima. Nor does Teshima disclose any equivalent structure or function. Teshima says nothing about managing a list of exam descriptions; he says nothing about selecting an exam description from a stored list of exam descriptions; and he says nothing about constructing a data object that includes both an image file and an associated exam description selected from that list.

It is a mistake to state that a prior art reference teaches something that it does not teach. If the Teshima reference truly

disclosed an "exam description list manager", it should be possible to cite an extract in Teshima that is no more than three or four lines in support of that proposition. Instead, the Examiner has cited a tract extending from column 13, line 49 to column 14, line 59, that is 79 lines long. Unfortunately, increasing the length of the cited extract cannot disguise the fact that the claim limitation in issue is not there or anywhere else in the reference.

The same is true for the Roewer patent. In support of the rejection of claim 2, the Examiner states:

Roewer discloses the system wherein said exam description list manager is further programmed to insert a new exam description in alphabetical order in said list in response to entry of said new exam description in an Edit field on said display screen and activation of a virtual Add button on said display screen.

In support of this proposition, the Examiner cites 49 lines of text in columns 12 and 13 of Roewer. But close scrutiny of the cited extract again reveals that no mention of any list of exam descriptions, let alone managing and selecting from such a list. Instead, the text starting at column 12, line 57, merely discloses that an operator can write text information into an image frame when the text input mode is activated. More specifically, Roewer states (at col. 12, lines 59-61):

When the text input mode is activated, any of the alphabetic, numeric, or special keys on the keyboard can be used to write in a selected frame.

(Emphasis added). Roewer says nothing about selecting an item

from a list of exam descriptions and then incorporating the selected exam description with an image file in a data object.

Similarly, in support of the rejection of claim 5, the Examiner asserts that Roewer teaches an imaging system having means for displaying a user-interactive menu comprising a multiplicity of aligned fields for displaying a list of exam descriptions, one exam description per field, and an edit field for entry of an exam description, as well as means for editing the list based on the entry in the Edit field. As previously noted, Roewer nowhere discloses a list of exam descriptions. Nor does Roewer mention an "Edit field" or any functionally equivalent means for adding items to the exam description list. Roewer discloses only that "when the text input mode is activated, any of the alphabetic, numeric, or special keys on the keyboard can be used to write in a selected frame". This bears no resemblance to Applicant's user-interactive menu with fields for list items and a separate Edit field for entering each item to be added.

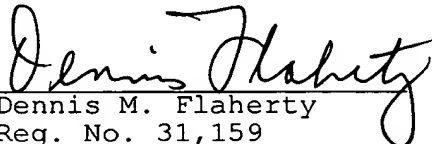
In summary, the Examiner has failed to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met by the Examiner, as set forth at MPEP 706.02(j). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of

success. Finally, the combined prior art references must teach or suggest all the claim limitations. The Examiner has failed to satisfy this last criterion. The combination of Teshima and Roewer does not teach or suggest all of the limitations of Applicant's claims because neither reference shows an "exam description list manager" (as recited in independent claims 1 and 17) or a computer programmed to display, edit and store a list of exam descriptions (as recited in independent claim 11) or an imaging system having a graphical user interface having an Edit field for entry of a new or changed exam description and a multiplicity of aligned fields containing respective exam descriptions of a list (as recited in claim 5). The dependent claims are patentable at least for the same reasons that claims 1, 5, 11 and 17 are patentable. In addition, neither cited reference teaches the alphabetic ordering of exam descriptions in a managed list (as substantially recited in dependent claims 2 and 18) or the alphabetic ordering of exam descriptions in a linked list (as recited in dependent claims 6 and 12). Consequently, the Applicant respectfully submits that the rejection of claims 1-18 as being unpatentable over Teshima in view of Roewer should be withdrawn.

In view of the foregoing, the Applicant submits that this application is now in condition for allowance. Reconsideration of the application and allowance of claims 1-18 are hereby requested.

Respectfully submitted,

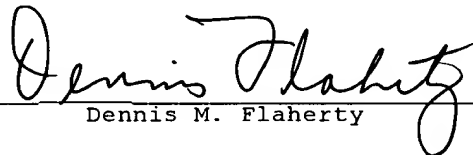
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January 15, 2003
Date


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